

RECEIVED  
CENTRAL FAX CENTER

AUG 18 2005

PATENT  
Attorney Docket No. 215851  
Client Reference No. 20755-div2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ikemoto et al.

Art Unit: 1621

Application No. 10/086,076

Examiner: M. L. Shippen

Filed: February 28, 2002

For: PRODUCTION METHOD OF CITALOPRAM,  
INTERMEDIATE THEREFOR AND PRODUCTION  
METHOD OF THE INTERMEDIATE

AMENDMENT, PETITION, AND FEE DELETING CORRECTLY  
NAMED PERSON WHO IS NOT INVENTOR OF INVENTION  
NOW BEING CLAIMED  
- NONPROVISIONAL APPLICATION - 37 C.F.R. § 1.48(b)

Mail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

1. This amendment and petition under 37 C.F.R. § 1.48(b) is to delete Mr. Wei-Guo GAO, who was originally named as an inventor for this application and who is not an inventor of the invention now being claimed. This amendment and petition, signed by a party set forth in 37 C.F.R. § 1.33(b), to correct the inventorship of this application, identifies the aforementioned inventor as being the inventor to be deleted and hereby acknowledges that the aforementioned inventor's invention is no longer being claimed in this nonprovisional application.

2. Fee (37 C.F.R. § 1.17(i) - \$130.00)

Method of Payment of Fees

- ☐ Attached is a check in the amount of \$ .
- ☒ Charge Deposit Account No. 12-1216 in the amount of \$130.00. (A duplicate copy of this communication is enclosed for that purpose.)

08/19/2005 LWONDIM1 00000003 121216 10086076

01 FC:1464 130.00 DA


In re Application of Ikemoto et al.  
Application No. 10/086,076

Authorization to Charge Additional Fees

- ☒ If any additional fees are owed in connection with this communication, please charge Deposit Account No. 12-1216. (A duplicate copy of this communication is enclosed for that purpose.)

Instructions as to Overpayment

- ☒ Credit Account No. 12-1216.  
☐ Refund

  
\_\_\_\_\_  
John Kilyk, Jr., Reg. No. 39,763  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: March 1, 2004

Paper \_\_\_\_\_

Filed on behalf of Party  
By:

Ikemoto  
John Kilyk, Jr., Reg. No. 30,763  
Bruce M. Gagala, Reg. No. 28,844  
Christopher T. Griffith, Reg. No. 33,589  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 N. Stetson Avenue  
Chicago, Illinois 60601  
Telephone: (312) 616-5600  
Facsimile: (312) 616-5700  
Email: jkilyk@leydig.com

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

---

**HANS PETERSEN  
and  
MICHAEL HAROLD ROCK  
(Application 09/794,755)**

**Junior Party**

**v.**

**TETSUYA IKEMOTO, WEI-GUO GAO,  
and  
MASAMI IGI  
(Application 10/086,076)**

**Senior Party**

---

**Patent Interference No. 105,075**

---

**IKEMOTO MOTION TO CORRECT INVENTORSHIP**

z

## TABLE OF CONTENTS

	<u>Page</u>
I. STATEMENT RELIEF REQUESTED .....	1
II. THE EVIDENCE RELIED UPON BY IKEMOTO .....	1
III. STATEMENT OF MATERIAL FACTS .....	2
IV. FULL STATEMENT OF THE REASONS WHY REQUESTED RELIEF SHOULD BE GRANTED .....	3
V. CONCLUSION .....	4

**I. STATEMENT RELIEF REQUESTED**

Party Ikemoto moves in accordance with 37 C.F.R. §§ 1.48(b) and 1.634 to correct inventorship of its Application No. 10/086,076 by deleting Mr. Wei-Guo Gao as a named inventor.

**II. THE EVIDENCE RELIED UPON BY IKEMOTO**

EXHIBIT 1011 – Ikemoto Application No. 10/086,076, "Combined Declaration and Power of Attorney" submitted with application on February 28, 2002.

EXHIBIT 1012 – Ikemoto Application No. 10/086,076, "Preliminary Amendment" dated February 28, 2004.

EXHIBIT 1013 – Ikemoto Application No. 10/086,076, "Amendment, Petition and Fee Deleting Correctly Named Person Who Is Not Inventor of Invention Now Being Claimed – Nonprovisional Application – 37 C.F.R. § 1.48(b)" dated April 15, 2002.

EXHIBIT 1014 – Ikemoto Application No. 10/086,076, "Office Action" (Restriction Requirement) dated May 30, 2002.

EXHIBIT 1015 – Ikemoto Application No. 10/086,076, "Response to Restriction Requirement" dated June 28, 2002.

EXHIBIT 1016 – Ikemoto Application No. 10/086,076, "Office Action" dated August 8, 2002.

EXHIBIT 1017 – Ikemoto Application No. 10/086,076, "Response to Office Action and Request for Interference" dated September 3, 2002.

### III. STATEMENT OF MATERIAL FACTS

1. Ikemoto's Application No. 10/086,076 is a divisional application of Application No. 09/654,768.
2. The specification and claims of Ikemoto's Application No. 10/086,076, as filed, consisted of a copy of Ikemoto's parent Application No. 09/654,768, which contained claims 1-20.
3. Concurrently with the filing of Application No. 10/086,076, Ikemoto filed a copy of the "Combined Declaration and Power of Attorney" from Ikemoto's parent Application No. 09/654,768, which correctly identified the following persons as inventors: Tetsuya IKEMOTO, Wei-Guo GAO, Nobuhiro ARAI, and Masami IGI (Exhibit 1011).
4. By way of the "Preliminary Amendment" filed concurrently with Application No. 10/086,076, Ikemoto canceled originally filed claims 8-16 and 18-20 and maintained claims 1-7 and 17 because claims 8-16 and 18-20 were pursued in the parent Application No. 09/654,768 and related divisional Application No. 09/996,134 and because claims 1-7 and 17 were canceled in response to a restriction requirement in the parent Application No. 09/654,768 (Exhibit 1012).
5. By way of the "Amendment, Petition, and Fee Deleting Correctly Named Person Who Is Not Inventor of Invention Now Being Claimed – Nonprovisional Application – 37 C.F.R. §1.48(b)," Ikemoto deleted Mr. Nobuhiro ARAI as an inventor in view of the claims canceled by way of the aforementioned "Preliminary Amendment" (Exhibit 1013).
6. As a result, Ikemoto's Application No. 10/086,076 currently names the following persons as inventors: Tetsuya IKEMOTO, Wei-Guo GAO, and Masami IGI.

7. A seven-way restriction requirement was made by the Patent Office during the prosecution of Ikemoto's Application No. 10/086,076 as between claims 1, 2, 3, 4-5, 6, 7, and 17 (Exhibit 1014).

8. In response to the restriction requirement, Ikemoto made an election of the invention of claim 17 without traverse (Exhibit 1015).

9. The Patent Office subsequently issued an "Office Action (Exhibit 1016), and Ikemoto canceled claims 1-7 as drawn to nonelected inventions and added new claims 21-28 by way of its "Response to Office Action" (Exhibit 1017).

10. At the time Ikemoto canceled claims 1-7 and added claims 21-28, Ikemoto inadvertently, and without deceptive intent, failed to appreciate that Mr. Wei-Guo Gao was a co-inventor as to nonelected inventions of the canceled claims, but was not a co-inventor as to the inventions of the remaining claims 17 and 21-28 (of which claim 17 is being canceled in accordance with the Board's directive recited in the "Order Setting Times" and "Correction to Order Setting Times," both dated December 23, 2003). Now, having appreciated the error, Ikemoto hereby promptly moves under 37 C.F.R. § 1.634 to correct inventorship pursuant to 37 C.F.R. § 1.48(b).

#### **IV. FULL STATEMENT OF THE REASONS WHY REQUESTED RELIEF SHOULD BE GRANTED**

Ikemoto's Application No. 10/086,076 was filed with claims 1-20, which constituted the originally filed claims of the parent Application No. 09/654,768, and correctly named the same inventors as parent Application No. 09/654,768 for originally filed claims 1-20 (Ikemoto Facts 1-3). The currently pending claims of Ikemoto's Application No. 10/086,076 are the result of (a) the cancellation of originally filed claims

8-16 and 18-20 (which claims were pursued in the parent Application No. 09/654,768) and (b) the cancellation of originally filed claims 1-7 (which claims were cancelled in response to a restriction requirement in Ikemoto's Application No. 10/086,076) along with the addition of new claims 21-28 (Ikemoto Facts 4-9).

After originally filed claims 8-16 and 18-20 were cancelled, Ikemoto amended inventorship to comport the inventorship with the subject matter defined by the remaining claims (Ikemoto Facts 4-6). After originally filed claims 1-7 were cancelled (and new claims 21-28 were added) in response to the restriction requirement in Ikemoto's Application No. 10/086,076, Ikemoto inadvertently, and without deceptive intent, failed to appreciate that Mr. Wei-Guo Gao was a co-inventor as to nonelected subject matter of cancelled claims 1-7 but was not a co-inventor of subject matter of the remaining claims 17 and 21-28 (Ikemoto Facts 7-10).

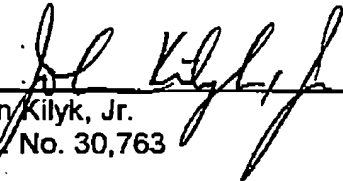
Now, having appreciated its error, Ikemoto promptly moves to correct inventorship of its Application No. 10/086,076 by deleting Mr. Wei-Guo Gao as an inventor, thereby properly naming Mr. Tetsuya Ikemoto and Mr. Masami Igi as the only inventors of the subject matter defined by the currently pending claims.

## V. CONCLUSION

For the foregoing reasons, Ikemoto submits that its Motion to Correct Inventorship should be granted and therefore submits and requests entry of the accompanying "Amendment, Petition, and Fee Deleting Correctly Named Person Who Is Not Inventor of Invention Now Being Claimed – Nonprovisional Application – 37 C.F.R. § 1.48(b)" effecting the deletion of Mr. Wei-Guo Gao as a co-inventor in its Application No. 10/086,076.

Respectfully submitted,

Date: March 1, 2004

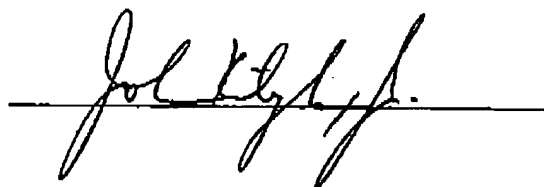
  
\_\_\_\_\_  
John Kilyk, Jr.  
Reg. No. 30,763

**CERTIFICATE OF SERVICE**

I hereby certify that this IKEMOTO MOTION TO CORRECT INVENTORSHIP has been forwarded by Federal Express on March 1, 2004, to:

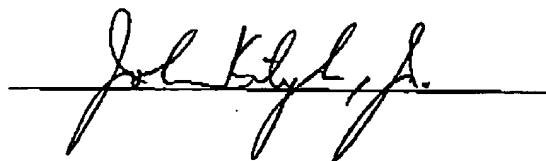
Attorney for PETERSEN:

S. Peter Ludwig, Esq.  
Robert Schaffer, Esq.  
DARBY & DARBY, P.C.  
805 Third Avenue  
New York, New York 10022

A handwritten signature in cursive script, appearing to read "John K. H. J.", is written over a horizontal line.

**CERTIFICATE OF DELIVERY**

I hereby certify that this IKEMOTO MOTION TO CORRECT INVENTORSHIP has been forwarded by Federal Express on March 1, 2004, Board of Patent Appeals and Interferences, Crystal Gateway 2, 10<sup>th</sup> Floor, 1225 Jefferson Davis Highway, Arlington, Virginia 22202.

A handwritten signature in cursive script, appearing to read "John K. H. J.", is written over a horizontal line.



**Invoice Number:** 1-631-56566  
**Invoice Date:** Mar 11, 2004  
**Account Number:** 0606-1113-0  
**Page:** 9 of 37

## FedEx Express Shipment Detail By Payor Type (Original)

**Dropped off:** Mar 01, 2004

**Payor:** Shipper

**Reference:** 225207/TAK

- Fuel Surcharge - FedEx has applied a fuel surcharge of 6.50% to this shipment.
- Distance Based Pricing, Zone 4
- FedEx has audited this shipment for correct packages, weight, and service. Any changes made are reflected in the invoice amount.

<b>InternetShip</b>		<b>Sender</b>	<b>Recipient</b>
Tracking ID	790565200346	RICK MADSEN	BOARD OF PATENT APPEALS
Service Type	FedEx Priority Overnight	LEYDIG VOIT & MAYER	AND INTERFERENCE
Package Type	FedEx Pak	180 N STETSON AVE STE 4900	CRYSTAL GATEWAY TWO, 10TH FLOOR
Zone	4	CHICAGO IL 60601-6731 US	ARLINGTON VA 22202 US
Packages	1		
Weight	2.0 lbs. 0.9 kgs	Transportation Charge	25.50
Delivered	Mar 02, 2004 10:10	Discount	-6.12
Svc Area	A1	Fuel Surcharge	1.26
Signed by	Y.PRATHER		
FedEx Use	539699350/01530/	<b>Total Charge</b>	<b>USD \$ 20.64</b>

Paper 69

Filed by:

Motions Panel  
Interference Trial Section  
Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
Mail Stop Interference  
P. O. Box 1450  
Alexandria, VA 22313-1450  
Tel: 571-272-9797  
Fax: 571-273-0042

Filed:  
January 10, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

HANS PETERSEN  
and  
MICHAEL HAROLD ROCK  
(Application 09/794,755)

Junior Party,

v.

TETSUYA IKEMOTO, WEI-GUO GAO,  
and  
MASAMI IGI  
(Application 10/086,076)

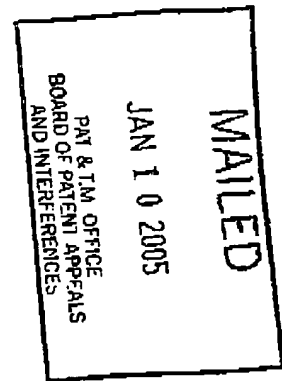
Senior Party

Patent Interference 105,075

Before McKELVEY, Senior Administrative Patent Judge, SCHAFER, and MOORE,  
Administrative Patent Judges.

MOORE, Administrative Patent Judge.

Judgment - Merits - Bd.R. 127



Interference 105,075

Paper 69

Upon consideration of Petersen Preliminary Motions 1-3, Petersen Miscellaneous Motion 4, Ikemoto Preliminary Motions 1-3, Ikemoto Motion to Correct Inventorship, and for the reasons given in the DECISION ON PRELIMINARY MOTIONS (Papers 67 and 68), it is:

**ORDERED** that Petersen Preliminary Motions 1-3 and Miscellaneous Motion 4 (Papers 23, 24, 25, and 26) are dismissed.

**FURTHER ORDERED** that Ikemoto Motion to Correct Inventorship (Paper 46) is granted.

**FURTHER ORDERED** that Ikemoto Preliminary Motion 1 (Paper 29) is dismissed.

**FURTHER ORDERED** that Ikemoto Preliminary Motion 2 (Paper 50) is denied.

**FURTHER ORDERED** that Ikemoto Preliminary Motion 3 (Paper 51) is granted.

**FURTHER ORDERED** that Petersen is not entitled to a patent containing Petersen claims 6 and 7 of involved Petersen application 09/794,755, filed February 26, 2001.

**FURTHER ORDERED** that entry of this judgment constitutes a final decision in this interference [37 CFR §41.2--definition of "final"—reprinted in 69 Fed. Reg. at 50003 (Aug. 12, 2004)].

**FURTHER ORDERED** that a copy of each DECISION ON PRELIMINARY MOTIONS (Papers 67 and 68) and this JUDGMENT shall be placed in the file of (1) application 09/794,755 and (2) application 10/086,076.

Interference 105,075

Paper 69

**FURTHER ORDERED** that if there is a settlement agreement, attention is directed to 35 U.S.C. §135(c) and 37 CFR §41.205, reprinted in 69 Fed. Reg. at 50019 (Aug. 12, 2004).

*mck*  
\_\_\_\_\_)  
FRED E. McKELVEY  
Senior Administrative Patent Judge  
\_\_\_\_\_)  
*RES*  
\_\_\_\_\_) BOARD OF PATENT  
RICHARD E. SCHAFER  
Administrative Patent Judge  
\_\_\_\_\_) APPEALS  
\_\_\_\_\_) AND  
\_\_\_\_\_) INTERFERENCES  
*James T. Moore*  
\_\_\_\_\_)  
JAMES T. MOORE  
Administrative Patent Judge  
\_\_\_\_\_)

Date: January 10, 2005  
Alexandria, VA

AUG. 18. 2005 5:25PM LVM 312 616 5700

NO. 9923 P. 20

Interference 105,075

Paper 69

cc (via fax and mail):

Attorney for PETERSEN:

S. Peter Ludwig  
DARBY & DARBY, P.C.  
805 Third Avenue  
New York, NY 10022  
Fax: 212-753-6237

Attorney for IKEMOTO:

John Kilyk Jr., Esq.  
LEYDIG, VOIT & MAYER, LTD  
Two Prudential Plaza, Suite 4900  
180 North Stetson Avenue  
Chicago, Illinois 60601-6780  
Fax : 312-616-5700